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Ray R. Regan, Registration No. 36,899

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	Steve B. Taylor
Sole Inventor:	Steve B. Taylor
For:	A Coupler
Filing Date:	June 20, 2003
Application Number:	10/600,379
Attorney Docket Number:	2236.001
Group Art Unit:	3679
Examiner:	Victor MacArthur

Best Available Copy

**APPELLANT'S AMENDED APPEAL BRIEF  
FOLLOWING REOPENED PROSECUTION**

To: Mail Stop APPEAL BRIEFS-PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

As provided in 37 C.F.R. Subpart B ("*Ex Parte* Appeals") §§41.30 *et seq.*, Appellant submits this Appeal Brief in connection with the above-identified application with the Board of Patent Appeals and Interferences ("Board").

Applicant requests the Board to overrule the Examiner's rejections and to allow the rejected claims in the application.

Appellant filed a Notice of Appeal with the Board on December 16, 2005. In the Notice of Appeal, Appellant requested reinstatement of the earlier appeal as provided in MPEP §1204.01, and application of fees previously paid by Appellant toward the fees for this appeal, a request Appellant confirms in connection with fees for filing this Brief.

The Commissioner is hereby authorized, however, to charge any fees to Account Number 501565 for the Law Office of Ray R. Regan, P. A., and to deposit any overpayments to Account Number 501565.

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**(1) REAL PARTY IN INTEREST**

The real party in interest is the Appellant, Steve B. Taylor, an individual, whose mailing address is 4908 Hawkins, N.E., Albuquerque, New Mexico 87109, and whose residence address is 9718 Avenida del Oso, N.E., Albuquerque, New Mexico 87111.

**(2) RELATED APPEALS AND INTERFERENCES**

No other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

**(3) STATUS OF CLAIMS**

Claims 1-22 are pending in the application.

Claims 23-31 have been cancelled.

Claims 1-22 have been finally rejected and are being appealed.

As stated in Section (9) of this Brief, the appealed claims are set forth in **Appendix A**.

**(4) STATUS OF AMENDMENTS**

On August 23, 2005 the Examiner reopened prosecution of the application following a first appeal brief filed by Appellant ("Reopened Prosecution") by filing an office action asserting new arguments ("Reopened Office Action") Appellant filed a reply which led to the Examiner filing a final office action ("Reopened Final Action"). Appellant filed no claim amendments subsequent to the Reopened Final Action. Indeed, no claim amendments have been filed in connection with any office action.

Perhaps in an excess of caution, however, if the term "amendment" in 37 CFR §41.37(c)(iv) is deemed to refer to a paper entitled "reply" or "response" to an office action,

rather than an amendment of a claim, Appellant confirms that Appellant did file a Reply to the Reopened Final Rejection, and simultaneously filed the Notice of Appeal to the Board. The Examiner expressly entered the Reply to the Reopened Final Rejection.

## **(5) SUMMARY OF THE CLAIMED SUBJECT MATTER**

A. The apparatus of independent claim 1 is a variably positionable coupler 10 mountable on a curved surface 38'. Coupler 10 is shown by cross-reference between Figures 1-8B. A curved surface 38' is shown in Figures 1 and 3, and described and explained in the specification of the application at page 1, lines 28-29 carried over to page 2, lines 1-26, which also explains why the claimed coupler is needed in the industry. The apparatus of independent claim 1 also includes a base 12 formed with an upper side 14 and a lower side 16, the lower side 16 being is a substantially flat planar surface as shown in Figure 4. The base 12 is shown by cross-reference between Figures 1-3 and 5-9B. The base is described and explained in the specification at page 3, lines 28-29 carried over to page 4, line 1; and at page 6, lines 12-29 carried over to page 7, lines 1-4. The coupler 10 includes means 36 for mounting the base 12 on the curved surface 38'. The mounting means 36 preferably includes one or more ball washer assemblies 40 -- not merely a ball washer -- as explained in the specification at page 4, lines 1-2; page 7, lines 5-25; and shown by cross-reference between Figures 2-4. A tub 70 is provided that is adjustably connectable to the base 12. Tub 70 is shown be cross-reference between Figures 2-3, 5-8B, and shown separately in Figures 10A-C. Tub 70 is described and explained in the specification on page 4, lines 3-6; page 8, lines 4-12 and lines 20-21; page 9, lines 3-6 and 27-29 carried over to page 10, lines 1-8. A plug 72 that is repositionably attachable to the tub 70 is included. The plug 72 is shown be cross-reference between Figures 2-3, 5-8B, and shown separately in Figures 11A-C. Plug 72 is described and explained in the specification on page 4, lines 3-4; page 8, lines 4-24; and page 9, lines 13-16 and 27-29 carried over to page 10, lines 1-8. In addition, a neck 74, rotatably insertable in the plug 72, is provided for securing a shaft 110 shown in Figure 14 to the neck 74. Neck 74 is shown by cross-reference between Figures 2-3, 5-8B, and separately in Figures 12A-C. Neck 74 is described and explained in the specification on

page 4, lines 3-6; page 8, lines 25-29 carried over to page 9, lines 1-6; and on page 10, lines 13-20. A clevis mechanism 96 that is slidably and demountably engageable with the plug 72 and the neck 74 is included. The clevis mechanism 96 is shown by cross-reference between Figures 2, 5-8B, and separately in Figure 13. The clevis mechanism 96 is described and explained in the specification on page 4, lines 5-6; page 6, lines 14-15; page 8, lines 22-24; page 9, lines 4-16; and page 10, lines 1-9.

B. The apparatus of independent claim 11 is a coupler system 10 that includes a base 12 formed with opposing yokes 18a,b. Coupler system 10 is shown by cross-reference between Figures 1-8B. The apparatus includes a base 12. The base 12 is shown by cross-reference between Figures 1-3 and 5-9B. The base is described and explained in the specification at page 3, lines 28-29 carried over to page 4, line 1; and at page 6, lines 12-29 carried over to page 7, lines 1-4. Opposing yokes 18a,b are shown by cross-reference between Figures 1-2, 5-8B, and separately in Figures 9A-9B. Opposing yokes 18a,b are described and explained in the specification on page 6, lines 12-14 and lines 20-25; page 8, lines 11-12; and page 9, lines 27-28. The apparatus of independent claim 11 also includes means 36 formed in the base 12 for mounting the base 12 on a curved surface 38'. The means 36 mounting the base 12 on surface 38' preferably includes one or more ball washer assemblies 40 as explained in the specification at page 4, lines 1-2, and page 7, lines 5-25, and shown by cross-reference between Figures 2-4. The coupler system 10 also includes a plurality of ball washer assemblies 40 combinable with the mounting means 36. Also included is a boom-swivel device 68 detachably fixable to the base 12 for securing a shaft 110 to the coupler system 10. The boom-swivel device is explained and described in the specification on page 6, line 14; page 6, lines 12-13; and page 8, lines 4-12, where the boom-swivel device is defined to include the tub 70 adjustably connectable to base 12, the plug 72 repositionably attachable to tub 70, and neck 74 rotatably insertable in plug 72. The various components of the coupler system are shown by cross-reference between figures 1-13.

**(6) GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL**

A. Claims 1-3 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,697,320 to Murray.

B. Claim 4 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 5,704,749 to Landgrebe.

C. Claim 5 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 5,704,749 to Landgrebe as applied to claim 4, and further in view of U.S. Patent No. 1,257,536 issued to Schroeder (“Schroeder Patent”).

D. Claims 6-13 and 16-22 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 1,257,536 issued to Schroeder.

E. Claims 14-15 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 1,257,536 issued to Schroeder, as applied to claim 13, further in view of U.S. Patent No. 5,704,749 to Landgrebe.

F. Claim 11 stands rejected under 35 U.S.C. §112, first paragraph, as not providing enablement for “a plurality of ball washer assemblies combinable with the mounting means.”



**(7) ARGUMENTS**

**A. Claims 1-3 Not Anticipated Under 35 U.S.C. § 102(b) by U.S. Patent No. 5,697,320 to Murray**

**1. Rejection of Independent Claim 1**

On page 4 of the Office Action the Examiner rejected independent claim 1 (and dependent claims 2-3) as anticipated by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 (“Murray Patent”), an argument that Appellant respectfully traverses. Accordingly, Appellant respectfully urges the Board to overrule the rejection of independent claim 1.

35 U.S.C. §102 (b), cited by the Examiner as the basis for rejection of Claims 1-3, provides:

“A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....”

Appellant respectfully submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale in this country, more than one year prior to the date of filing of the present application in the United States. Independent claim 1 is patentable (and therefore the dependent claims 2-3 are patentable) because the Murray Patent does not anticipate independent claim 1.

a. **Predicate.** As a predicate applicable to the rejections in the Reopened Final Action, it is appropriate to consider the problem of burgeoning analytical differences among those involved with the patenting process, differences that may account in part to a corresponding escalation in the number of appeals.

During the past decade, decisions from the U.S. Supreme Court, the Court of Appeals of the Federal Circuit, and arguments advanced by the examining cadre in the Patent Office, often seem at odds with (i) the Manual of Patent Examining Procedure (“MPEP”), (ii) the consistent decisions of the Board, and (iii) the understanding of patent practitioners.

There is, of course, the “Festo Factor.” Regardless of how the cumulative ten decisions now classified as “Festo” are read or interpreted, one implication looms clearly: any amendment made to a patent application during prosecution virtually assures later challenge as having been made “for purposes of patentability,” and therefore to eliminate the salutary benefits of the Doctrine of Equivalents. Accordingly, comments such as the following still found in the MPEP are now wholly without credence: “During patent examination, the pending claims must be ‘given their broadest reasonable interpretation consistent with the specification. Applicant always has the opportunity to amend the claims during prosecution...” MPEP §2111. In view of *Festo*, the underlined portion of that section of the MPEP clearly is incorrect.

Indeed, because almost any claim amendment may prospectively be recast as having been entered “for purposes of patentability,” practitioners now are advised that the Supreme Court has established “amendment and appeal as opposite paths to be taken.” In other words, one should always appeal, rather than amend claims. *See Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives*, Susan Perng Pan, “Journal of the Patent and Trademark Office Society,” Vol. 85, No. 11 (November, 2003), page 853, at 855 *et seq.* As required by MPEP §1206, a copy of the article is included with this Brief at Supplement A.

In addition to dilemmas posed by the Festo Factor, the examining cadre occasionally invokes arguments that may be seen as a stretch to denying patentability. On page 3 of the Examiner’s Final Office Action the Examiner argues:

“Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface within the broadest reasonable interpretation of the claim language.”

Several problems arise from the Examiner’s assertion:

First, Appellant submits that such an argument seems inconsistent with the spirit of *ex parte* examination. The Examiner’s argument seems to be this: Although Appellant’s arguments

are valid, they are irrelevant because the Examiner may reject claims based on the “broadest reasonable interpretation of claim language.” A corollary to that kind of argument would be that during examination, no regard need be paid to the specification, its definitions, or its explanations. However, in the words of MPEP the interpretations of an examiner must be reasonable.

Second if neither the definitions nor explanations and descriptions provided in the specification of a patent application have meaning, why should an Applicant include them in an application?

Third, the argument that the examiners need consider only the “broadest reasonable interpretation of claim language” is incorrect. MPEP §2111.01 does not state that claims must be given their broadest reasonable interpretation. Rather, that section clearly requires that “...claims must be given their broadest reasonable interpretation consistent with the specification.” Those four words, “consistent with the specification,” significantly modify application of the rule.

Fourth, the “broad interpretation” provision also indicates that “broad” interpretation is not the goal. MPEP §2111.01 states that “...broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified.” In other words, an examiner should indeed read the claims “in light of the specification,” but should not read limitations into a claim.

Fifth, the Examiner’s assertion attempts to address only one of two important alternative issues in this case: Curvature of a surface is one issue. Design and functionality of Appellant’s coupler to accommodate a curved surface that cannot be accommodated by the apparatus in the references cited by the Examiner is a different issue. As will be shown by Appellant, the device cited by the Examiner as anticipating Appellant’s coupler could not be mounted on a curved surface without changing the principle of operation of that device, contrary to MPEP §2143.01.

Clearly, therefore, claims are not to be examined by giving them their broadest possible interpretation. Rather, pending claims are to be given their broadest reasonable interpretation consistent with the specification. That is logical; claims are not drafted in a vacuum, but are shaped, defined, and given meaning by the specification of the application.

Fortunately, the Board is in agreement. Although not binding precedent, the analytical approach taken in recent decisions continues to support the long-standing rules set forth above: see Ex parte Cynthia L. Cassel, et al., Appeal No. 2002-1893 pertaining to Application No. 09/767,413, and Ex parte Kyle D. Wessells, et al., Appeal No. 2004-0462 pertaining to Application No. 09/915,861. In both cases, the Board gave due consideration not only to the claims, but also to the specification.

In light of that background, Appellant will now address the arguments advanced by the Examiner in this case.

b. **All-Elements Rule Not Met.** The Murray Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

Specifically, the Murray Patent does not anticipate claim 1 of the Application for at least these reasons:

1) **The Murray Apparatus is not Variably Positonable.** On page 6 of the Office Action the Examiner asserts that the Murray Patent discloses a “variably positionable” coupler, an argument advanced because Appellant’s independent claim 1 is directed to a variably positionable coupler. The apparatus of the Murray Patent, however, is not “variably positionable” as that term is defined in the Application at page 2, lines 8-26:

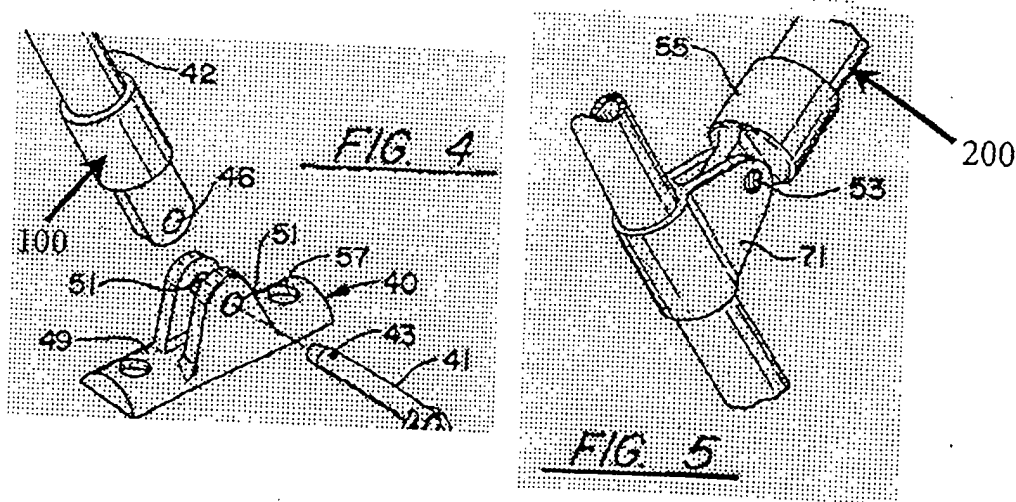
[A] previously unaddressed need exists in the industry for a new and useful apparatus, and method for manufacturing such an apparatus, capable of being mounted on a curved mounting surface that also is capable of being adjusted to accommodate any dimension and configuration of boat hull or other structure to which the apparatus is attached. Particularly, there is a significant need for a variably positionable coupler system mountable on a curved surface that overcomes the effects of forces that may be applied to a shaft mounted on such a coupler system...[I]n the boat industry, no effort has been made to offer a standardized variably positionable coupler that is universally adjustable for

accommodation to any dimension of the boat, any dimension of shafts, and to any shape of the hull of a craft, including a curved surface. (Emphases added.)

The apparatus of the Murray Patent is not universally adjustable.

As is evident from the marked-up figures shown by the Examiner on page 4 of the Office Action, and reproduced below, the component that the Examiner labeled “tub 100” allows leg 42 to be positionable in one plane only. Together, components 42 and 100 may rotate only in one plane around the axis formed when quick release pin 41 is inserted through apertures 52 (see Murray Patent, column 3, lines 58-64, and Figures 4-5, reproduced below).

**FIGURES 4-5 OF MURRAY PATENT**



Appellant's coupler, however, is not limited to restricted rotation in a single plane. Rather, Appellant's coupler is variably positionable and universally adjustable for mounting on any shape of hull of a craft, including a curved surface.

These unique features of Appellant's coupler, among others, is emphasized and demonstrated by Appellant's drawing Figures 5-8B, reproduced below.

In addition to Figures 5-8B depicted above, the “Brief Description of the Drawing” beginning on page 5 of the Application amplifies what the Figures show and demonstrate

# **FIGURES 5-8B OF APPLICATION**

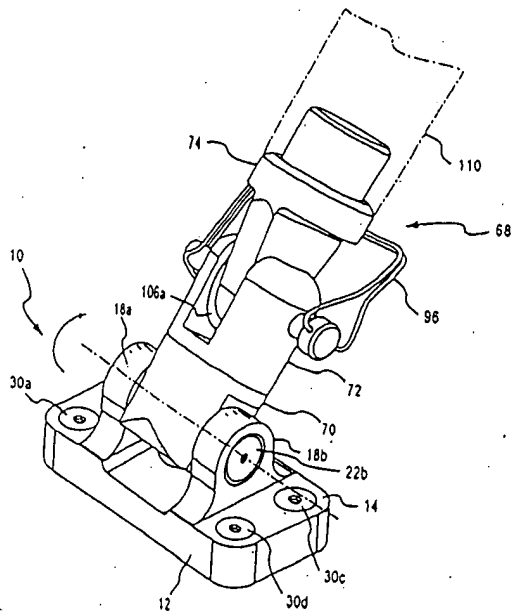


FIG. 5

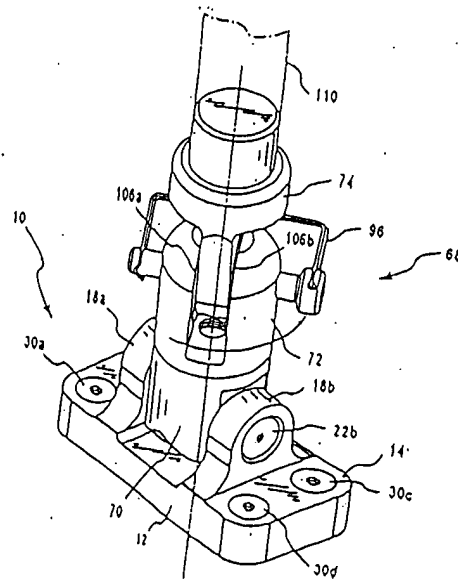


FIG. 6

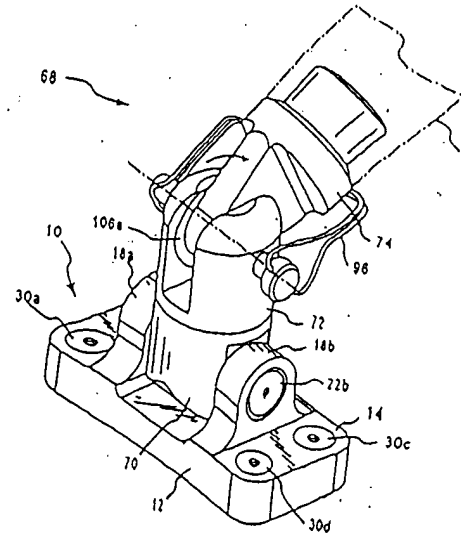


FIG. 7

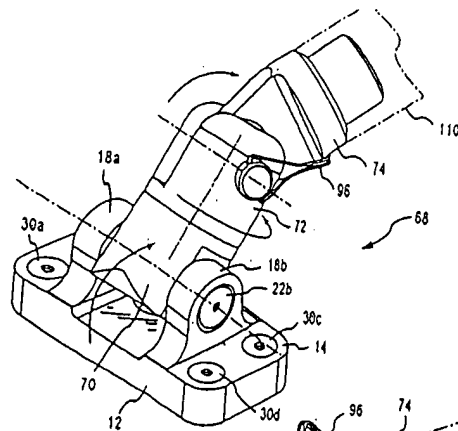


FIG. 8A

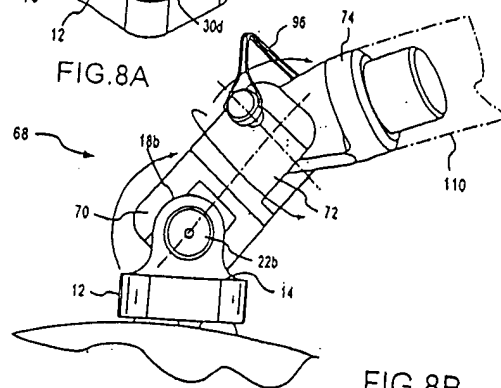


FIG. 8B

In addition to Figures 5-8B depicted above, the “Brief Description of the Drawing” beginning on page 5 of the Application amplifies what the Figures show and demonstrate (emphasis added):

Figure 5 is a perspective view of the coupler showing possible variable positions;

Figure 6 is a perspective view showing yet another of the variable positions of the coupler;

Figure 7 is a perspective view showing another variable position of the coupler;

Figure 8A is a perspective view showing another variable position of the coupler;

Figure 8B shows another variable position of the coupler on the ball washers...

As Appellant understands the arguments of the Examiner, the Examiner believes that the device shown in Figures 4-5 of the Murray Patent is variably positionable and universally adjustable for mounting on any shape of hull of a craft, including a curved surface.

To the contrary, if “tub 100” in Fig. 4 were turned or rotated 90 degrees, for example -- which presupposes that “tub 100” is not rigidly mounted, which it is -- component 42 could not be rotated around an axis defined by pin 41 as intended.

Restated, the Examiner seems to assert that the structural components shown in Fig. 4 of the Murray Patent include all structural components of Appellant’s coupler shown in Figures 5-8B of the Application. In fact, that is incorrect. Assuming only for the sake of analysis that neck 74 shown in Appellant’s Figure 8A is akin to what the Examiner has labeled “tub 100” in Figure 4 of the Murray Patent, and that clevis mechanism 96 installed through neck 74 and plug 72 of the coupler in Appellant’s Figure 8A are akin to pin 41, the Examiner’s arguments disregard the remaining components in Appellant’s coupler that make the coupler variably positionable and universally adjustable for mounting on any shape of hull of a craft, including a curved surface. Thus, as shown in Figures 5-8B, the coupler’s tub 70 and base 12 and ball washer assemblies 40, that contribute to making the coupler variably positionable and universally adjustable have no equivalent component in Figures 4-5 of the Murray Patent. And lacking those elements, the Murray device cannot possibly achieve the variable positioning and mounting achieved by

Applicant's coupler.

Thus, as shown in Figures 5 through 8B of Appellant's Application, the semi-circular arrows demonstrate that the components of Appellant's coupler are positionable not merely in one plane like the Murray apparatus, but in a wide variety of positions, in a wide range of varying planes, along an array of combinations and permutations of x-, y-, and z-axes.

For example, Figure 6 on page 12 of this Brief demonstrates the mechanical departure of the coupler from the Murray apparatus. The semi-circular arrow shown on plug 72 of coupler 10 shows the variable positions of the coupler, demonstrating that because of the unique use of plug 72 in combination with, and mechanical cooperation with, neck 74 and tub 70, components of coupler 10 may also and simultaneously rotate around at least a y-axis. Figure 7 shows that a segmented portion of coupler 10, namely neck 74, may rotate around yet another z-axis. As indicated in the "Brief Description of the Drawing," Figure 8A shows that tub 70 may rotate around the axis formed by first threaded bolts 22a,b in opposing yokes 18a,b, while at the same time plug 72 may rotate in relationship to tub 70, while at the same time neck 74 may be variably positioned in yet another plane or direction -- all of which is shown again for emphasis, from an alternative perspective, in Figure 8B which also demonstrates that the flat bottomed base 12 is securely fastenable to a curved surface through the use of the ball washer assemblies 40.

Thus it is clear that for at least these reasons the Murray Patent fails to fairly meet the all-elements rule, and for that reason alone independent claim 1 should be allowed.

2) **Structural Differences** Marked-up Figures 4 and 5 from the Murray Patent are reproduced for an additional reason. In an earlier office action the Examiner stated that Appellant "does not fully appreciate that figures 4 and 5 show separate sections of the assembly of figure 1." The Examiner went on to state: "Figures 1, 4 and 5, as depicted together above, show that element 100, while similar in structure to element 55, is in addition to and assembled away from element 55." (Emphasis added.) Appellant respectfully disagreed then, and raises this again to show how the structure and cooperation of structure of the Murray Patent and Appellant's coupler are completely different.

Element 100 and element 55 in Figures 4 and 5 are identical, not similar, in structure; the



differences in structure occur in connection with the configuration of the substrate on which component 100 and component 55 are mounted. Thus, component 100 is mounted on base 49 having a flat planar surface, whereas component 55 is mounted on a tube formed with T-fitting slides 71. Again, the structural difference resides in the different substrates, not in component 100 and component 55.

Also germane is the fact that under no interpretation of the components of the Murray apparatus can either Figure 4 or Figure 5 be construed to show the tub and plug of Appellant's apparatus, an argument made clear in subparagraph 3. below.

In addition, it is evident that the Examiner's efforts to identify in the Murray apparatus the elements of Appellant's coupler are incorrect in fact, and incorrect mechanically. Thus, on pages 6-7 of the Office Action the Examiner asserts that the Murray Patent shows "a tub...adjustably connectable to the base...[and] a plug...repositionably attachable to the tub...[and] a neck rotatably insertable in the plug...." That assertion fails when that same assertion includes the reference numerals assigned by the Examiner to the components of the Murray apparatus. The Examiner attempts by hindsight to reconstruct Appellant's coupler by stating that component 100 is a "tub," and that component 42 is a "plug" repositionably attachable to the tub. Component 42 is, however, not reasonably comparable to the variably positionable plug 72 of Appellant's coupler. Indeed, component 42 is described in the Murray Patent as one of the "legs" of the U-shaped structure that supports the canopy: see Murray Patent, column 3, lines 8-11, lines 33-38, lines 55-60, and column 4, lines 1-7. If comparable to any elements of Appellant's coupler, leg 42 would be shaft 110, shown in Appellant's Figure 5 -- which is connectable to neck 74, not tub 70.

Accordingly, the elements of Appellant's coupler, and the components of the Murray apparatus are neither comparable to the coupler, nor do they cooperate in the same manner.

Accordingly, for at least this structural reason the Murray Patent does not satisfy the all-elements rule of MPEP §2131, and rejection of claim 1 therefore should be withdrawn.

3) **The Murray Apparatus is Not Mountable on a Curved Surface.** On page 6 of the Office Action the Examiner asserts that the apparatus of the Murray

Patent is mountable on a curved surface. Appellant respectfully disagrees.

(a) The marked-up figures from the Murray Patent confirm that the underside of base 42 is flat. The Examiner concedes that the underside of base 42 is a “flat planar surface.” See Office Action, page 4. A flat planar surface is not designed for mounting on a curved surface. Nothing in the Murray Patent suggests or teaches that the Murray apparatus is intended to be mountable on a curved surface, and the Examiner points to none.

(b) The Examiner asserts that his marked-up portion of Figure 1 of the Murray Patent shows the Murray apparatus mounted on “a curved surface of the watercrafts as seen in figure 1” (see Office Action, page 6). Appellant disagrees. Figure 1 of the Murray Patent shows the Murray apparatus mounted on a flat upper surface, or deck, of the watercraft. The Examiner has offered no proof as part of the Examiner’s *prima facie* case that the deck on which the Murray apparatus is mounted is curved. Regardless, the flat planar surface is not designed for mounting on a curved surface. As is evident from Figures 4-5 of the Murray Patent, the base element is flat. To accommodate a curved surface, the flat surface would have to be contoured out to conform to a curved surface. But even then, it would only fit a specific curved surface coincident with the contouring. That would change the principle of operation of the Murray device, contrary to MPEP §2143.02.

Accordingly, for at least these structural reasons the Murray Patent does not satisfy the all-elements rule of MPEP §2131, and the rejections of claim 1 therefore should be overruled.

(c) The Examiner asserts, however, a second argument about curved surfaces. The second argument is inconsistent with the assertion that the Murray Patent shows the Murray apparatus mounted on “a curved surface of the watercrafts as seen in figure 1.” The second argument appears on page 7 of the Office Action. There the Examiner states:

(Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface with the broadest reasonable interpretation of the claim language.) [Emphasis added.]

Appellant has several responses to the Examiner's argument.

First, as already indicated the Murray apparatus has no curved surface. Accordingly, there is no "Murray curved surface."

Second, if the Examiner asserts that the body of the watercraft shown in the Murray Patent "curves elsewhere," as also indicated above there is no evidence of that fact.

Third, to argue that the surface of the watercraft shown simply must curve elsewhere or somewhere fails to recognize that the Murray Patent shows the Murray Apparatus mounted on flat surfaces, and that the Murray Patent makes no comment about its efficacy when mounted on a curved surface.

Fourth, Appellant respectfully disagrees that such an argument either is "reasonable" or is "the broadest reasonable interpretation of the claim language." See Office Action, page 7. Claim language must be read in light of the specification. As shown above, the specification emphasizes that one of the unique features of Appellant's coupler is that it can be mounted on any curved surface. Nothing in the specification of the Murray Patent suggests that attribute. As noted, the Examiner's argument seems to be this: Although Appellant's arguments are valid, they are irrelevant because the Examiner may reject claims based on the "broadest reasonable interpretation of claim language." The corollary to that argument would be that during examination, no regard need be paid to the specification, its definitions, and its explanations. However, as stated above, the Examiner's statement of the rule is incomplete: MPEP §2111.01 does not state that pending claims must be given their broadest reasonable interpretation. Rather, that section clearly requires that "...pending claims must be given their broadest reasonable interpretation consistent with the specification." (Emphasis added.) MPEP §2111 goes on to state that the claims should be considered "...as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description..." (Emphasis added.) Clearly, therefore, claims are not to be examined by giving them their broadest possible interpretation. Rather, pending claims are to be given their broadest reasonable interpretation, the "reasonableness" being with reference to the specification. That is logical. Claims are not drafted in a vacuum, but are shaped, defined, and given meaning by the specification of an application.

4) **The Murray Patent Does Not Disclose Either a Plug or a Neck.**

The Murray Patent also does not satisfy the “all-elements” rule of MPEP §2131 because the Murray Patent does not disclose either a plug or a neck as Appellant has defined and described plug 72 and neck 74 and shown them by cross-reference between Figures 5-8B.

An element of Appellant’s independent claim 1 is a plug repositonably attachable to the tub. See Listing of Claims, page 6, line 10. The plug is shown in Figure 2 of the Application as plug 72, and is reproduced above.

The Examiner asserts on page 7 of the Office Action that the Murray Patent discloses a plug. The plug of the Murray Patent, as proposed by the Examiner, consists of (i) a component 42, (ii) “upper portion of 42,” and (iii) a component 71. See Office Action, page 4, lines 3-2 of the bottom of that page. The Murray Patent, however, assigns reference numeral 42 to one of two legs 42 and 44. See Murray Patent, column 3, lines 55-60. The Examiner’s term of “upper portion of 42” would apparently, therefore, refer to the upper portion of leg 42 -- which extends, as shown in Figure 2 of the Murray Patent, all the way up to canopy 22. The “upper portion of [leg]” does not, therefore, as claimed by Appellant, cooperate structurally with a neck rotatably insertable in the plug as claimed by Appellant. Indeed, as shown in the Examiner’s marked up version of Figure 5 of the Murray Patent, the Examiner states three lines from the bottom of page 4 of the Reopened Final Action that component numbered 100 by the Examiner is a “tub (100).” Yet the Examiner states two lines from the bottom of page 4 that component numbered 55 is purportedly a “neck (55).” As already shown, however, components 100 and 55 are the same components shown from different perspectives and mounted on different substrates. Regardless, the same component cannot be both a tub and a neck, with or without an undefined component described as an “upper portion of [leg] 42”. The addition of an undefined component 71, which in fact is called a “T-fitting” in the specification of the Murray Patent, does not, Appellant respectfully submits, support the Examiner’s structural arguments. See Murray Patent, column 4, line 12.

The Examiner’s argument on page 14 of the Office Action is, therefore, without merit. There the Examiner argues that “the fact that the Murray plug is of a two-piece construction is irrelevant since the Appellant does not claim one-piece construction.” See Office Action, page

14. That argument by the Examiner is unpersuasive. When claiming an element of a claim, no rule of patent law requires that each claim recite that the element is on one-piece construction. In addition, the Figure above shows that the plug is of one-piece construction. Finally, the tub and plug that the Examiner tries to fashion from the Murray apparatus do not cooperate in the same fashion as does the tub and plug of Appellant's apparatus.

Accordingly, contrary to the Examiner's assertion that the Murray Patent discloses a plug and a neck, it does not, and at least for that reason the rejections of claim 1 should be overruled.

For these reasons, and for the reasons articulated below, Appellant respectfully requests that the Board overrule the rejection of claim 1 under 35 U.S.C. §102(b).

#### 5) Discussion of Rejections under 35 U.S.C. §102

The fundamental teaching on the doctrine of anticipation was set forth by Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim.

*In re William J. King* at 231 USPQ 139 (emphasis added).

Further, as provided in MPEP §2131, for a reference to anticipate a claim, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). "Anticipation" is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (Emphasis added)

As discussed above, the Murray Patent does not disclose the identical structure and cooperation of structure as described in the Application.

Appellant, therefore, respectfully urges that the Murray Patent does not anticipate claim 1 of Appellant's coupler, and that the rejection be overruled.

**B. Claim 4 Is Not Unpatentable Under 35 U.S.C. § 103(a) over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 5,704,749 to Landgrebe**

On page 7 of the Office Action the Examiner rejected dependent claim 4 under 35 U.S.C. §103(a), claiming obviousness over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe ("Landgrebe Patent").

However, because the Murray Patent does not anticipate independent claim 1, dependent claim 4 is allowable.

In addition, 35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set for in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Appellant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejections of the claim, Appellant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above.

Moreover, as stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference "must expressly or impliedly suggest the claimed invention...." (Emphasis added)

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Appellant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Indeed, in connection with all §103 arguments advanced by the Examiner, Appellant submits that the attempted combinations urged by the Examiner are individually and collectively impermissible hindsight prohibited by both the Board of Patent Appeals and Interferences (“Board”), and the Court of Appeals for the Federal Circuit (“CAFC”). The case of *Ex parte Wessels and Kaido*, Appeal No. 2004-0462, Application No. 09/915, 861, is an example. While the case is not binding precedent of the Board, the methodology of analysis based on *In re Fritch* is instructive:

[I]t is our opinion that the examiner has used the hindsight benefit of appellant’s own disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chosen disparate elements or concepts in an attempt to reconstruct appellant’s claimed subject matter. However, as our court of review [CAFC] indicated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or “template” in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. (Emphasis added.)

The Examiner concedes that the Murray Patent does not disclose a frustoconical recess. See Final Office Action, page 8. The Examiner asserts, however, that the Landgrebe Patent does so, and that for some reason, not explained, it would have been obvious to modify the coupler of Murray to include the frustoconical recesses as taught by the Landgrebe Patent. Appellant respectfully traverses the Examiner’s inductive leap.

As indicated above, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited

references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....” The Examiner points to nothing in either reference that might provide either a suggestion or motivation to modify the Murray apparatus, or to combine the teachings.

Accordingly, Appellant respectfully urges that the Murray Patent does not anticipate claim 1 of Appellant's coupler, and that the rejection be overruled.

**C. Claim 5 Is Not Unpatentable Under 35 U.S.C. § 103(a) over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 5,704,749 to Landgrebe**

On page 8 of the Office Action the Examiner argues that Claim 5 is unpatentable under 35 U.S.C. §103(a) over the Murray Patent in view of the Landgrebe Patent, further in view of U.S. Patent No. 1,257,536 issued to Schroeder on February 26, 1918 (“Schroeder Patent”).

As predicate to overcoming the rejection, Appellant adopts and incorporates by reference the arguments of Appellant made in connection with the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 above .

Preliminarily, because the Murray Patent does not anticipate independent claim 1, dependent claim 5 is allowable.

In addition, the Examiner states that the Murray Patent does not disclose the types of washers and fasteners that might be used to mount the Murray apparatus on a surface. The Examiner also concedes that the Schroeder Patent is limited in application to “land vehicles.” According to the Examiner, however, it would have been obvious to use ball washer means to combine the references.

Once again, however, as indicated above, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....” The Examiner points to nothing in either reference that might provide either a suggestion or motivation to modify the Murray



apparatus, or to combine the teachings. The limitation of the Schroeder Patent in connection with land vehicles appears to remove that reference from consideration in Appellant's environment. Although the Examiner argues on page 8 of the Office Action that "it would have been obvious...to adapt the means for mounting, as taught by Schroeder, to be used at each hole of the Murray means for mounting," once again the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support such an argument.

Accordingly, Appellant respectfully urges that the Murray Patent does not anticipate claim 1 of Appellant's coupler, and that the rejection be overruled.

**D. Claims 6-13 and 16-22 Are Not Unpatentable over U.S. Patent No. 5,697,320**  
**Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

Beginning on page 9 of the Office Action the Examiner argued that Claims 6-13 and 16-22 are unpatentable under 35 U.S.C. §103(a) over the Murray Patent in view of the Schroeder Patent.

Appellant traverses the arguments, and asserts that none of the rejected claims is unpatentable.

To begin with, 35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set for in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Appellant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejections, Appellant adopts and incorporates by reference the arguments of Appellant made in connection with the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 above .

Moreover, for emphasis, as stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....”

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Appellant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Indeed, in connection with all §103 arguments advanced by the Examiner, Appellant submits that the attempted combinations urged by the Examiner are individually and collectively impermissible hindsight prohibited by both the Board of Patent Appeals and Interferences (“Board”), and the Court of Appeals for the Federal Circuit (“CAFC”). The case of *Ex parte Wessels and Kaido*, Appeal No. 2004-0462, Application No. 09/915, 861, is an example. While the case is not binding precedent of the Board, the methodology of analysis based on *In re Fritch* is instructive:

[I]t is our opinion that the examiner has used the hindsight benefit of appellant’s own disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chosen disparate elements or concepts in an attempt to reconstruct appellant’ claimed subject matter. However, as our court of review [CAFC] indicated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or “template” in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. (Emphasis added.)

Further, although the Examiner asserts that it would be permissible to modify the coupler by incorporating features of the Schroeder Patent, Appellant respectfully submits it is improper to modify the coupler utilizing that reference. See MPEP §2143.01, the heading of which states that “The Proposed Modification Cannot change the Principle of Operation of a Reference.” To combine the references in the manner sought by the Examiner is an application of impermissible hindsight in the analysis of Appellant’s novel coupler, and would require impermissible modification of the principles of operation of Appellant’s coupler.

More specifically:

1. **Claims 6-10 Are Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

It is evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor’s recommended use of the Schroeder device on first “a horizontal body portion,” and second, on a “vertical portion.” Unlike the variably positionable coupler claimed and disclosed by Appellant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted “sideways.” See Figures 1 and 2.

The Examiner evidently tries to meet the requirement of MPEP §706 by advancing an argument that the Murray Patent includes the kind of suggestion contemplated by MPEP §706 that would support a *prima facie* case of obviousness. The argument by the Examiner appears to be that the Murray Patent “suggests [in] (col. 2, ll. 61-65) adaptation for use on land vehicles but does not detail such adaptation.” (Emphasis added.) For the Examiner, that deficiency, apparently, is resolved by the Schroeder Patent because that patent states that “ball washer means for mounting are beneficial for mounting components in a variety of positions found on land vehicles (automobiles).” The Examiner concludes, therefore, that it would have been obvious to “adapt the Murray means for mounting to a land vehicle...by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder....” Using the terms used

by the Examiner, this paper will refer to the foregoing argument of the Examiner as the “Land Vehicle Argument.”

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant’s disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, Appellant respectfully urges that the rejections of claims 6-10 be overruled.

2. **Claim 11 Is Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

The Examiner rejected independent claim 11 for obviousness. See pages 8-11 of the Office Action.

In doing so, the Examiner again invoked the arguments advanced in connection with claims 6-13, including the Land Vehicle Argument.

Independent claim 11, however, claims a boom-swivel device 68 that is detachably fixable to base 12. The claims dependent from independent claim 11, and the specification of the Application, show that boom-swivel device 68 includes at least one tub 70 (see claim 19), a plug 72 (see claim 20), and a neck 74 (see claim 21); see also Figures 5-8B reproduced above.

Incorporating by reference all arguments made in this paper in connection with those elements of the coupler, Appellant submits that Appellant has overcome the rejections of the Examiner.

As Appellant has pointed out, there is neither a suggestion nor motivation recited in either reference to combine elements in the novel manner of Appellant's coupler, nor any teaching of all the claim limitations. Accordingly although the Examiner argues that "it would have been obvious...to adapt the washer assembly, as taught by Schroeder, to be combined with each hole of the Murray means for mounting...", the Examiner points to no suggestion, motivation, or teaching recited in either reference to support the argument.

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant's disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

In addition, Schroeder offers no teaching or suggestion that the Schroeder device is mountable on a curved surface. Attempting to combine the elements of the Murray Patent with the elements of the Schroeder Patent would result in an assembly that certainly would not be stationary on a curved surface, and could rotate only in one plane. Contrary to the Examiner's

argument, the Schroeder ball washer assembly is not “beneficial for mounting components in a variety of positions,” but rather only on a horizontal or vertical position. See Schroeder Patent, column 2, lines 64-80.

Figure 1 of the Schroeder Patent shows the use of only one ball washer. Figure 1 also shows only flat surfaces on the components. Movement of those components in relationship to a longitudinal axis through the ball washer and bolt would be restricted to at best an estimate 5-10 degree movement. It is only when one or more ball washers are combined into the ball washer assemblies 40 included in Appellant’s coupler that the coupler can accommodate a curved surface.

Accordingly, Appellant respectfully requests that the Board overrule the rejection of independent claim 11.

3. **Claims 12-13 and 16-22 Are Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

As Appellant has indicated above, it is evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor’s recommended use of the Schroeder device on first “a horizontal body portion,” and second, on a “vertical portion.” Unlike the variably positionable coupler claimed and disclosed by Appellant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted “sideways.” See Figures 1 and 2.

The Examiner evidently tries to meet the requirement of MPEP §706 by advancing an argument that the Murray Patent includes the kind of suggestion contemplated by MPEP §706 that would support a *prima facie* case of obviousness. The argument by the Examiner appears to be that the Murray Patent “suggests [in] (col. 2, ll. 61-65) adaptation for use on land vehicles but does not detail such adaptation.” For the Examiner, that deficiency, apparently, is resolved by the Schroeder Patent because it states that “ball washer means for mounting are beneficial for mounting components in a variety of positions found on land vehicles (automobiles).” The

Examiner concludes, therefore, that it would have been obvious to “adapt the Murray means for mounting to a land vehicle...by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder....”

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant’s disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, Appellant respectfully urges that the rejections of claims 6-10 be overruled.

#### 4. Further Discussion of 35 U.S.C. §103

Regarding the foregoing analysis of the Examiner’s arguments invoking 35 U.S.C. §103, Appellant emphasizes that for the Examiner to establish a *prima facie* case of obviousness based on a combination of the content of various references, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the Appellant.” *In re Creg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re Raynes*, 7

F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), emphasis added. In other words, it is not enough to be able to combine elements or features; the references must suggest the combination advanced by the Examiner.

In addition, “obviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Creg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re Gorham*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Contrary to the Examiner’s goal in this case, to modify Appellant’s invention as shown in the Examiner’s “marked up” figures, and thus to modify prior art references to render a patent obvious, requires that “the prior art suggested the desirability of the modification.” *In Re Fitch*, 23 USPQ2d 1784 (Fed. Cir. 1992). There is nothing in the cited references that suggest the desirability of the proposed modification.

It is also clear that a reference teaches away from an invention, and therefore cannot be cited as a reference for rejections, when “it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the Appellant.” *In re Gurley*, 27 Fed. 3rd 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). In reading such a reference, explained the court, the Examiner must ask if a person of ordinary skill in the art would have been discouraged from following the path set out in the reference, or “would [have been] led to a direction divergent from the path taken by the Appellant.” *In re Gurley*, at 1131. In other words, teaching away is the antithesis of suggesting that a person of ordinary skill in the art proceed in the direction taken by the Appellant. In this case, the references cited do not even consider mounting a flat, planar device on a curved surface. The references include no suggestion at all that a person should consider what the Appellant invented.

In view of these ageless references about what is “obvious” under 35 U.S.C. §103(a), Appellant respectfully urges that the claims be allowed. The structure as both disclosed in the Application, and claimed, differs from the structure disclosed in the references. The references cited by the Examiner do not disclose the cooperation of structure of Appellant’s coupler. The references disclose no teaching or suggestion to support the notion that the coupler is obvious in view of the combination of references cited by the Examiner.



There also is no evidence supporting the Examiner's arguments. Recent decisions of the Court of Appeals, Federal Circuit require such evidence. The Federal Circuit emphasizes that evidence must support the assertion of a suggestion, teaching, or motivation; if there is no evidence of such a suggestion, teaching, or motivation, it is inappropriate to "make the inventor's disclosure a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Debiczak*, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The evidence, in other words, must show a "skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Court also emphasized the proof required by confirming that "[a] rejection cannot be predicated on the mere identification...of individual components of claimed inventions. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Appellant respectfully submits that the Examiner has used the hindsight benefit of Appellant's disclosure to pick and choose elements or concepts from the distinctly different apparatus of the applied references, and then selectively combine disparate elements or features in an attempt to reconstruct appellant's claimed subject matter, contrary to *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). In the *Fritch* case the court held that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

**E. Claims 14-15 Are Not Unpatentable under 35 U.S.C. §103(a) Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder as Applied to claim 13 in Further View of U.S. Patent No. 5,704,749 to Landgrebe**

On page 12 of the Office Action, the Examiner rejected dependent claims 14-15 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent, in further view of the Landgrebe Patent.

Appellant incorporates all of the foregoing arguments, and states that dependent claims 14-15 are allowable for at least the same reasons that support allowability of the claims discussed above.

Nothing in any of the cited references suggests or teaches the modifications or combinations argued by the Examiner.

**F. Claim 11 Improperly Rejected under 35 U.S.C. §112/1**

On page 3 of the Office Action the Examiner rejected claim 11 under 35 U.S.C. §112/1. Appellant respectfully traverses the rejection.

The Examiner stated that “the problem” with claim 11 “is that it requires a plurality of ball washer assemblies that are not the means for mounting (as provided in the Specification) but rather are combinable with the means for mounting.”

Claim 11 recites (emphasis added):

11. A coupler system, comprising:  
a base formed with opposing yokes;  
means formed in the base for mounting the base on a curved surface;  
a plurality of ball washer assemblies combinable with the mounting means; and  
a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.

The capitalization of the word “Specification” by the Examiner in identifying the asserted “problem” with claim 11, and the argument advanced by the Examiner about “new matter” (addressed below), suggest that the Examiner believes that the term “specification” does not include the drawing figures and claims. If so, that is incorrect.

The term “specification” includes the drawing figures, the description, and the claims. *See Landis on Mechanics of Patent Claim Drafting*, Robert C. Faber, PLI, 4<sup>th</sup> Ed., Glossary, Appendix E. *See also* 37 CFR §1.71 (“The specification must include a written description....”) (emphasis added); 37 CFR §1.74 (“[w]hen there are drawings, there shall be a brief description of the several views...and the detailed description shall refer to the different views....”) (emphasis added); and 37 CFR §1.75 (“[t]he specification must conclude with a claim....”) (emphasis added). Thus, since time virtually immemorial, the “specification” has been known to include the description, drawing figures, and claims.

The Examiner may also view the element in independent claim 1 (“means for mounting the base on the curved surface”) as the same means claimed in independent claim 11 (“means formed in the base for mounting the base on a curved surface”). They are not the same means.

As stated in Appellant’s specification, “[A]s perhaps best shown in Figure 2, base 12 also includes one or more bores 24. As shown in Figure 2, one or more bores 24a-c are formed in base 12.” (Emphasis added.) Claim 11 is directed to “means formed in the base for mounting the base on a curved surface.” The ball washer assemblies 40 are not “formed in the base.”

The Examiner apparently supports the rejection by asserting: “[T]he means for mounting that consists of a plurality of ball washers is only one preferred embodiment...such that an equivalent means for mounting that is not one or more ball washers can be used.” Appellant agrees. The Examiner goes on, however, to state: “However the specification does not adequately describe any such equivalent means for mounting much less describe how a plurality of ball washers could be combined with such an equivalent means for mounting.”

Appellant is, however, only required to show one embodiment in the application. *See* 37 CFR §1.71(b), providing that the specification is to include a description “of a specific embodiment.” (Emphasis added.)

Accordingly, Appellant respectfully requests the Board to overrule this rejection.

The foregoing argument of the Examiner is an analogue of a “new matter” objection advanced by the Examiner and traversed by Appellant. Thus, on page 3 of the Office Action the Examiner objected to the amendment filed by Appellant on June 21, 2005 under 35 U.S.C. §132(a), arguing that the amendment introduced “new matter.”

Appellant respectfully traverses the objection.

The Examiner concedes that the specification is in fact “enabling for mounting means including one or more ball washers (sic, “washer”) assemblies,” citing the specification, page 4, lines 1-2 and page 7, lines 8-9. See the Office Action, page 3. Respectively, those portions of the specification provide (with emphasis added):

Means are provided for mounting the base on a curved surface. As will be explained, the mounting means preferably includes one or more ball washer assemblies.

As shown by cross-reference among Figures 1-4, mounting means 36, in a preferred embodiment of the present invention, is a plurality of ball washer assemblies 40.

Claim 11, the claim rejected by the Examiner, recites that what is claimed is (also with emphasis added):

11. A coupler system, comprising:  
a base formed with opposing yokes;  
means formed in the base for mounting the base on a curved surface;  
a plurality of ball washer assemblies combinable with the mounting means; and  
a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.

The Examiner argues that while the specification is enabling for mounting means including one or more ball washer assemblies, the specification “does not reasonably provide enablement for ‘a plurality of ball washer assemblies combinable with the mounting means’ (line 4 of claim 11).”

As Appellant understands the argument, it seems again to imply that the term “specification” does not include the drawing figures and claims. That is incorrect. The term

“specification” includes the drawing figures, the description, and the claims. See Landis on Mechanics of Patent Claim Drafting, Robert C. Faber, PLI, 4<sup>th</sup> Ed., Glossary, Appendix E. See also 37 CFR §1.71 (“The specification must include a written description....”) (emphasis added); 37 CFR §1.74 (“[w]hen there are drawings, there shall be a brief description of the several views...and the detailed description shall refer to the different views....”) (emphasis added); and 37 CFR §1.75 (“[t]he specification must conclude with a claim....”) (emphasis added). Thus, since time virtually immemorial the “specification” has been known to include the description, drawing figures, and claims.

The words found in claim 11, and not amended during prosecution, were expressly provided for in the original claims, satisfying the test set forth in *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 55 USPQ2d 1650 (Fed. Cir. 2000) (“The fundamental inquiry [about a ‘new matter’ rejection] is whether the material added by amendment was inherently contained in the original application.”) The words “plurality of ball washer assemblies combinable with the mounting means” are not merely inherently contained in the original application, but expressly contained in the application.

Accordingly, the terms of claim 11, which are part of the specification, and provide for a plurality of ball washer assemblies combinable with the mounting means, may be included in the description of the specification to clarify the resulting patent.

The Examiner argues that: “The added material which is not supported by the original disclosure is...that ‘mounting means 36...is a plurality of bores 24a-d.’” Appellant respectfully disagrees. The specification clearly and expressly supports the amendment, which was tendered only to clarify the resulting patent. Thus, claim 11, which is part of the specification, provides for a “means formed in the base for mounting the base on a curved surface.” As previously indicated, the ball washer assemblies are not “formed in the base.” What are formed in the base? Bores are formed in the base. As recited in the Application, page 6, line 25, through page 7, line 4:

In addition, as perhaps best shown in Figure 2, base 12 also includes one or more bores 24. As shown in Figure 2, one or more bores 24a-d is formed in base 12. As shown in Figure 4, one or more bores 24 are also formed with a proximal end

26 and a distal end 28. One or more bores 24a-c are shaped for removable engagement of a second threaded bolt 30. Second threaded bolt 30 is perhaps best shown in Figure 4 as seconded threaded bolts 30c-d. As also shown in Figure 2, and by cross-reference among Figures 3-4, a frustoconical recess 32 is formed adjacent proximal end 26 of the one or more bores 24a-c in base 12. In addition, a concave cup 34 is formed adjacent distal end 28a-c of one or more bores 24 in base 12. (Emphasis added.)

No "new matter" has been entered. Accordingly, Appellant requests withdrawal of the objection.

### **Conclusion**

In view of the foregoing, Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Reopened Final Rejection of Claims 1-22 over the cited art, and hold that Appellants' Claims 1-22 are allowable.

Respectfully submitted,

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**(8) CLAIMS APPENDIX**

**Listing of Claims as Last Amended**

1. A variably positionable coupler mountable on a curved surface, comprising:  
a base formed with an upper side and a lower side,  
wherein the lower side is a substantially flat planar surface;  
means for mounting the base on the curved surface;  
a tub adjustably connectable to the base;  
a plug repositionably attachable to the tub;  
a neck rotatably insertable in the plug,  
wherein the neck is formed for securing a shaft to the neck; and  
a clevis mechanism slidably and demountably engageable with the plug and the neck.
2. A variably positionable coupler mountable on a curved surface as recited in claim 1,  
further comprising opposing yokes monolithically extending at substantially right angles from  
the upper side of the base.
3. A variably positionable coupler mountable on a curved surface as recited in claim 2,  
further comprising one or more bores formed in the base with a proximal end and a distal end,  
and further wherein the one or more bores are shaped for removable engagement with a bolt.
4. A variably positionable coupler mountable on a curved surface as recited in claim 3,  
further comprising a frustoconical recess formed adjacent the proximal end of the one or more  
bores.
5. A variably positionable coupler mountable on a curved surface as recited in claim 4,  
further comprising a concave cup formed adjacent the distal end of the one or more bores.

6. A variably positionable coupler mountable on a curved surface as recited in claim 1, wherein the mounting means is a plurality of ball washer assemblies.
7. A variably positionable coupler mountable on a curved surface as recited in claim 6, wherein the plurality of ball washer assemblies includes a second threaded bolt formed with a first diameter.
8. A variably positionable coupler mountable on a curved surface as recited in claim 7, wherein the plurality of ball washer assemblies includes a ball washer.
9. A variably positionable coupler mountable on a curved surface as recited in claim 8, wherein the ball washer is formed with a substantially hemispherical exterior surface, an interior surface, and a duct between the substantially hemispherical exterior surface and the interior surface formed with a second diameter larger than the first diameter of second threaded bolt.
10. A variably positionable coupler mountable on a curved surface as recited in claim 9, further comprising a nut assembly.
11. A coupler system, comprising:
  - a base formed with opposing yokes;
  - means formed in the base for mounting the base on a curved surface;
  - a plurality of ball washer assemblies combinable with the mounting means; and
  - a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.
12. A coupler system as recited in claim 11, wherein the opposing yokes are formed with opposing apertures.



13. A coupler system as recited in claim 11, wherein the mounting means includes a bore formed in the base.

14. A coupler system as recited in claim 13, wherein the mounting means includes a recess formed in one end of the bore.

15. A coupler system as recited in claim 14, wherein the mounting means includes a cup formed in the other end of the bore.

16. A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a bolt formed with a first diameter.

17. A coupler system as recited in claim 16, wherein the plurality of ball washer assemblies includes a ball washer formed with a duct having a second diameter larger than the first diameter of the bolt.

18. A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a nut assembly.

19. A coupler system as recited in claim 11, wherein the boom-swivel device includes at least one tub adjustably connectable to the opposing yokes.

20. A coupler system as recited in claim 11, wherein the boom-swivel device includes a plug repositionably attachable to the tub.

21. A coupler system as recited in claim 11, wherein the boom-swivel device includes a neck for supporting a shaft rotatably insertable in the plug.

22. A coupler system as recited in claim 11, wherein the boom-swivel device includes a clevis mechanism engageable with the plug and the neck.

**(9) EVIDENCE APPENDIX**

None.

**(10) RELATED PROCEEDINGS APPENDIX**

None.

## **Supplement A**

A copy of *Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives*, Susan Perng Pan, "Journal of the Patent and Trademark Office Society," Vol. 85, No. 11 (November, 2003) follows this page.

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## Notes from the Editor

This month we look at Appeals and Alternatives, Foreign-filed PCTs, and Traditional Knowledge and the New Mercantilism.

Susan Pan explores recent Board decisions versus continuing *ex parte* prosecution.

Sean Passino, Stephen Maebius and Hal Wegner analyze an asymmetry introduced by the ASPA with respect to foreign language-filed PCT applications.

Lastly, we conclude with the final installment of Shubha Ghosh's fascinating treatise on the tricky interface between traditional knowledge and contemporary IP protection.

That's all from here,  
Louis S. Zarfaz  
Editor-in-Chief

## Appealing a Rejection at the Board: Analysis of Recent Board Decisions and Non-Appeal Alternatives

Susan Perng Pan<sup>1</sup>

### ABSTRACT

This article discusses the merits of appealing rejections to the Board of Patent Appeals and Interferences in comparison to continued *ex parte* prosecution before the Examiner. The analysis takes into account recent decisions rendered by several patent panels and recent precedent of the Court of Appeals for the Federal Circuit. Recommendations are offered to place claims in better condition for appeal, types of arguments to be made and potential pitfalls to guard against.

### 1. TIMING FOR APPEAL

The timelines for Appeal and *ex parte* prosecution become intertwined because the U.S. patent statute permits appeal of a rejection in the following circumstances.

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.<sup>2</sup>

In implementing the statute, the patent office regulations permit an Applicant to appeal a rejection in an application for original patent either

<sup>1</sup> The author is a partner of Sughrue Mion, PLLC, Washington, D.C. Ms. Pan's practice includes litigation and extensive *ex parte* prosecution and appellate practice. The view expressed herein are solely those of the author.

<sup>2</sup> 35 U.S.C. § 134(a) (2000).

after receiving a final rejection or after two non-final rejections.<sup>3</sup> It is not necessary that all claims be twice rejected and it is sufficient to confer jurisdiction on the Board if any claim in the application satisfies this requirement. It is also not necessary that the rejection occur during prosecution of a single application, and it is sufficient if one claim is rejected both in a prior application and in a continuing application.<sup>4</sup>

The patent regulations thus permit Applicants the opportunity to obtain a final disposition of the patentability of their patent claims by appealing the Examiner's rejections prior to reaching a "final" *in passe* with the Examiner. Because Applicant has the choice to continue *ex parte* prosecution or pursue the appeal route, the decision should take account the strength of the claims and arguments in view of the cited art and whether the claims are in their best possible form prior to entering the appeal process.

## II. TO AMEND OR TO APPEAL: THE *FESTO* FACTOR

Given the option of 1) appealing a final rejection or a second non-final rejection or 2) pursuing prosecution on the merits by the filing of an Amendment or Response, an Applicant would be well-advised to press matters for patentability of the *originally filed* claims as far as possible before the Examiner. The Supreme Court's 2002 decision in *Festo* emphasizes the importance of appealing a rejection that Applicant views as patently incorrect as opposed to amending the claims in a response to an Office Action. "While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim."<sup>5</sup> When a claim is amended and narrowed whether for purposes of complying with a prior art rejection under 35 U.S.C. § 102 or § 103 or for purposes of clarifying the claim meaning under 35 U.S.C. § 112, the patentee is regarded as "having conceded an inability to claim the broader subject matter or at least as having abandoned the right to

<sup>3</sup> 37 C.F.R. § 1.191 (2000). The Rule further sets forth that for *ex parte* reexamination filed under Rule §1.510 for a patent that issued from an original application filed on or after November 29, 1999, no appeal may be filed until the claims are finally rejected.

<sup>4</sup> Manual of Patent Examining Procedure (hereafter "MPEP") §1205 (2002).

<sup>5</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 1840; 62 U.S.P.Q.2d (BNA) 1705, 1711 (2002).

appeal a rejection. In either case estoppel may apply."<sup>6</sup> The Supreme Court establishes amendment and appeal as opposite paths to be taken. Abandonment of the right to appeal, i.e. amending the claims, is taken as a strong concession. As a result of *Festo*, Applicants who amend claims without any explanation do so at their peril. "[W]hen a court is unable to determine the purpose underlying a narrowing amendment – and hence a rationale for limiting the estoppel to the surrender of particular equivalents [under the doctrine of equivalents]—the court should presume that the patentee surrendered all subject matter between the broader and narrower language."<sup>7</sup>

The *Festo* decision equates amendment with a surrender of the right to appeal, and that estoppel or surrender of equivalents arises from such amendment. This suggests that if the rejection of a broad independent claim is appealed, rather than amended, then estoppel may not apply or perhaps a less stringent estoppel may apply even if the claim is ultimately deemed unpatentable on appeal, because Applicant has not acquiesced to the Examiner's rejection. In view of the Federal Circuit precedent, during *ex parte* practice, an Applicant who can make a colorable argument of patentability over prior art without amending the claims should proceed to make such arguments. This approach should be taken even though amendatory material would strengthen the arguments. Such an Applicant will not have been deemed to have acquiesced in the rejection and not surrendered a wide swath of equivalents between the original and amended claim. As a safeguard, amendatory material can be placed in a separate dependent claim to test whether the amendatory material would be deemed to describe allowable subject matter.

Aside from the issue of scope of equivalents addressed by the Supreme Court, the Federal Circuit case law on dedication also suggests that narrowing claim amendments are a form of conscious waiver.

The patentee has control over the drafting of the claims, and if he discloses but omits to claim certain subject matter, he will be held to have waived the right to capture the disclosed matter under the doctrine of equivalents, and to have dedicated it to the public. No such waiver occurs where, as in *Graver Tank II*, the

<sup>6</sup> 122 S. Ct. at 1840; 62 U.S.P.Q. (BNA) at 1712.

<sup>7</sup> 122 S. Ct. at 1842; 62 U.S.P.Q.2d (BNA) at 1713.



patentee actually claimed the subject matter, even if the particular claims are later held invalid. There is, moreover, in such circumstances far less possibility that the patentee is "gaming" the system, that is, deliberately writing narrow claims with the objective of avoiding a searching PTO examination and recapturing the disclosed subject matter through the doctrine of equivalents.

In view of the negative consequences of failing to argue patentability to the fullest extent and pitfalls of dedication if broad claims are amended to exclude particular embodiments, it behooves an Applicant to strenuously fight any patentability rejections without amendment, if possible.<sup>8</sup>

### III. EVALUATING WHETHER TO APPEAL A REJECTION

Over the course of *ex parte* prosecution, the Applicant should continually evaluate the strength of the Examiner's rejection not only on the technical points underlying the rejection, but also the procedure applied in making the rejection and the rationale used to maintain any rejections. This evaluation will provide a better informed decision on whether an Appeal should be pursued.

In the event of a second non-final rejection under 35 U.S.C. § 102 or 103 in view of newly applied art, it is beneficial to respond to the rejection under 37 C.F.R. § 1.111. In view of such a non-finality, the Applicant still has the opportunity to obtain allowance of the claims in a timely manner without incurring the expense and time delays of an appeal. The most recent available figures from the U.S. Patent Office indicate that the Board of Patent Appeals is currently deciding appeals filed up to three years ago.<sup>9</sup> The opportunity to respond again under

<sup>8</sup> Johnson & Johnston v. R.E. Service Co., 285 F.3d 1046, 1060, 62 U.S.P.Q. (BNA) 1225, 1235 (Fed. Cir. 2002) (concurring opinion reconciling applicability of equivalents in *Graver Tank* and inapplicability of equivalents in the subject case).

<sup>9</sup> With the exception of a limited number of appeals involving special circumstances, the Board of Patent Appeals and Interferences is currently deciding appeals received at the Board as follows:

BIOTECH	Fiscal Year 2000
CHEMICAL	Fiscal Year 1999
ELECTRICAL	Fiscal Year 2000
MECHANICAL	Fiscal Year 2002
DESIGN	Fiscal Year 2002

These statistics were obtained from the U.S.P.T.O. website at [www.uspto.gov/web/offices/dcom/bpai/baiproducton.xls](http://www.uspto.gov/web/offices/dcom/bpai/baiproducton.xls).

Section 1.111 also affords the opportunity to develop the record further, which leads to either of two possible benefits.

As a first possibility, the Examiner will accept the arguments in the response as being sufficiently persuasive to place at least some of the claims in condition for allowance. At that juncture, the Applicant has the additional option of amending the claims to obtain allowance of some claims and filing a separate continuation application for any claims that remain rejected. As a second possibility, the Examiner will reject the arguments in the response as not being persuasive, but expand upon the rationale as to the lack of persuasiveness in a subsequent non-final or final rejection. The value of the second possibility necessarily relies on the nature of the response filed by the Applicant. This makes it very important to exercise precision in formulating the response rather than stating generalities. General denials submitted by the Applicant merely begot general denials from the Examiner, which is not helpful towards advancing a dialog with the Examiner, obtaining the patent or developing the record for appeal. For these same reasons, an Applicant should respond to a final rejection under 37 C.F.R. § 1.116 using the same strategy. In particular, for any Response to Arguments made by the Examiner, the Applicant should assess the underlying rationale and explain any weaknesses or inconsistencies in the Examiner's position.

Arguments directed towards patentability over prior art fall generally into two broad categories, technical arguments and legal arguments. Both types of arguments should be developed in responses filed under 37 C.F.R. § 1.111 and 1.116 prior to entering the appeal stage.

#### A. ANALYSIS OF RECENT DECISIONS

The decisions of the Board of Patent Appeals and Interferences dating from appeals filed during Fiscal Year 1993 are available through the U.S.P.T.O. website at [www.uspto.gov/web/offices/com/sol/foia/index.html](http://www.uspto.gov/web/offices/com/sol/foia/index.html). The database is searchable, through somewhat limited search constraints, at [www.uspto.gov/web/menu/search/html](http://www.uspto.gov/web/menu/search/html). A random sample of the decisions indicates that legal and technical arguments are equally effective in reversing Examiner rejections.<sup>10</sup>

A review of a number of recent Board Decisions reveals several analyses that are noteworthy. These particular decisions offer some

<sup>10</sup> The database of opinions runs several thousands in number. Approximately 200 decisions were reviewed in this assessment.

insight on "claim construction" approaches that have been taken by various panels, compares and contrasts effective arguments based on technical distinctions and legal arguments. It is noted that most, if not all, of the decisions posted to the website and all those discussed below are identified as "non-precedential" decisions that are not binding on the Board. If any weight is given to such decisions, the weight is severely limited.<sup>11</sup> However, in certain circumstances, the Federal Circuit which reviews appeal decisions of the Board, will give some weight to decisions designated as non-precedential.<sup>12</sup> For purposes of fashioning or evaluating arguments for purposes of appeal, a brief discussion of selected decisions follow.

### 1. Claim Interpretation Of Rejected Claims

In analyzing prior art rejections, Board decisions that address claim interpretation rely upon two seemingly opposite lines of legal precedent. Recent panels, following the mandate of the Supreme Court in *Markman v. Westview Instruments, Inc.*,<sup>13</sup> resort to Applicant's disclosure for purposes of interpreting the claims.<sup>14</sup> This appears to be contrary to the concept that during prosecution, the claims are to be given their broadest reasonable meaning and the scope of the claim cannot be narrowed by reading disclosed limitations in to the claim.<sup>15</sup> Several decisions of the Board do in fact resort to the specification and drawings for purposes of understanding the scope of a rejected claim.

Even though the panels have turned to the specification to interpret claims on appeal, any Applicant deciding whether to pursue an appeal

<sup>11</sup> See *Ex parte Theurer*, Appeal 96-2142 stating: Unpublished (or non-precedential) opinions of the Federal Circuit are not precedent in the Federal Circuit and will not be cited, considered or regarded as precedent by the EIC, the Board or any other tribunal within the Patent and Trademark Office.

<sup>12</sup> An opinion or order which is designated as not to be cited as precedent is one unanimously determined by the panel issuing it as not significantly adding to the body of law. Any opinion or order so designated must not be employed or cited as precedent. This rule does not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the court designated as non-precedential. Rules of the Court of Appeals for the Federal Circuit, Rule 47.6(b). Federal Circuit Rule 47.6(b) does not unconditionally prohibit citation of non-precedential opinions but instead permits citation of opinions for limited purposes. *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1337; 51 U.S.P.Q.2d (BNA) 1295, 1297 (Fed. Cir. 1999). See also *Anastasi v. United States*, 223 F.3d 899-905 (8th Cir.) holding that unpublished decision have precedential effect *vacated* 99-3917, 2000 WL 1863092 (8th Cir. 2000).

<sup>13</sup> 116 S.Ct. 1384; 38 U.S.P.Q.2d (BNA) 1461 (1996).

<sup>14</sup> *Ex parte Horstmann*, 1997-3241.

<sup>15</sup> *In re Morris*, 127 F.3d 1048, 1054; 44 U.S.P.Q.2d (BNA) 1023, 1027 (Fed. Cir. 1997).

based on existing claim language or whether to continue prosecution by one of several non-appeal alternatives discussed below, should consider whether their particular arguments can be supported by the context and broad concepts of the pending claim recitations. In such a case, it is possible that the broad concepts of the claim can be argued on appeal without modifying the claim language to specifically include the limitations in the specification. However, if the arguments must rely on actual limitations discussed in the specification but are unclaimed, then the Applicant would be better advised to amend the claim to describe the invention more specifically.

### A. CONCEPTUAL DISTINCTIONS BASED ON CONTEXT

In *Ex parte Schmidt*, 94-4239, the claim in question recited:

1. An extended field-of-view mirror, the mirror comprising:
  - (a) a convex reflective surface having a viewing area and a continuous perimetral edge surrounding the viewing area;
  - (b) an *opaque band integrally formed* with the reflective surface and depending therefrom, the opaque band substantially surrounding the entire reflective surface; and
  - (c) a mounting flange *integrally formed* with the opaque band and extending outwardly therefrom. (Emphasis added)

A central issue in the appeal was how to define the broad recitation "integrally formed with." The Board recognized that the specification provided no definition of the term, but turned to Fig. 4 of the application to determine that in the context of claim 1, "integrally formed with" meant that the mirror parts were joined together prior to any use of the mirror. In essence, the mirror included each of the cited components prior to its being secured to a mounting frame. In reversing the rejection, the Board noted that the cited art did not include the claim elements "integrally formed with" since a separate elastic ring was only part of the disclosed structure after being put into an interlocking relationship with a frame. The cited ring was thus "separate" and not integrally formed with the mirror prior to any use. The decision and definition of the phrase "integrally formed with" appears to have put significant weight on the context established by the claim preamble. In particular, it was "a mirror" that included several elements "integrally formed with" other elements. It is conceivable that a different outcome

would have resulted on appeal if the claim recited a "mirror assembly" rather than just a "mirror."<sup>16</sup>

The Board also resorted to Applicant's specification for claim construction purposes in *Ex parte Rahman*, 2001-1480. While acknowledging that claims should be given their broadest reasonable interpretation during prosecution, the Board further indicated that the terms in the claim should be construed as those skilled in the art would construe the claim.<sup>17</sup>

In *Rahman*, the claim in question recited:

A method for controlling traffic comprising:  
developing global positioning system information about a plurality of vehicles;  
analyzing traffic patterns based on said information;  
developing traffic control signals based on said traffic patterns; and  
transmitting said traffic control signals to traffic control devices. (Emphasis added).

Based on descriptions in the specification, the Board construed "traffic control devices" to comprise devices such as speed limit signs, traffic metering lights, traffic signs and traffic signals. The cited art disclosed transmission of route information to a microcontroller located on a vehicle. The Board considered that the transmission of traffic information to a vehicle was not a transmission of traffic control signals to "a traffic control device."

Under its broadest construction, the term "traffic control device" may comprise any device that would have an impact on traffic. It is not inconceivable that a controller in a vehicle would have some impact on traffic flows. Yet, in reversing the rejection, the Board's analysis appears to import definitional aspects of the term "a traffic control device" into the claims to limit the phrase to those listed in the specification. Obviously, given the Federal Circuit's directive in *In re Morris* and *In re Hiniker Co.*,<sup>18</sup> that emphasizes the importance of claim language rather than resort to the specification, an Applicant cannot be assured that the Board will use the specification so liberally in the appeal of any given

<sup>16</sup> The claim was rejected by the Board under 37 C.F.R. § 1.196(b), and that the subject claim was issued in U.S.P. 6,293,679 with substantive changes to the claim recitations.

<sup>17</sup> Citing *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986; 6 U.S.P.Q.2d (BNA) 1601, 1604 (CCPA 1977).

<sup>18</sup> *In re Hiniker*, 150 F.3d 1362, 1369; 47 U.S.P.Q.2d (BNA) 1523, 1529 (Fed. Cir. 1998).

case. However, the context of the claim recitation in *Rahman* also suggests that "vehicles" recited in the first element of the appealed claim are being distinguished from "traffic control devices" recited in the last element. Therefore, apart from the definitions imparted by the specification, the claims themselves would appear to warrant the construction afforded by the Board that a "traffic control device" is distinguishable from a "vehicle."<sup>19</sup>

## 2. Patentability Of Invention Based On Achieved Effects Over Prior Art

In some decisions reviewed for the preparation of this article, the panel did not specifically rely on the definition of a claim term in deciding the case. Rather, the rationale underlying reversal of the appealed rejections were cast in terms of the Applicant's discovery and solution of a new problem.

In *Ex parte Nella*, 1998-2753, the rejected claim recited:

A target detection, seeking and guidance system for an air-to-air, air-to-ground and/or ground-to-air missile comprising:  
a hyperspectral imaging system for detecting a target having a predetermined hyperspectral signature;  
means for enabling the missile to track the target matching the predetermined hyperspectral signature; and  
means including a missile controller for guiding the flight path of the missile to intercept the flight path of the target matching said predetermined hyperspectral signature.

The primary reference was directed generally towards missile guidance systems without specifically indicating that the targets were tracked by a hyperspectral signature. Three secondary references did teach hyperspectral imaging for scanning earthbound features such as mineral and vegetation deposits and for oceanographic and agricultural applications. The Examiner had deemed such earth-bound targets as corresponding to the "targets" in the claims. The claims themselves did not define what comprised "targets," and in reversing the rejection, the panel also did not specifically define what comprised a "target." Rather, the panel determined that reviewing the cited references, one skilled in the art would not have been motivated to combine the teachings in the manner proposed by the Examiner.

<sup>19</sup> The Board set forth a new ground of rejection under 37 C.F.R. § 1.196(b). The patent issued as U.S.P. 6,247,113 without any substantive amendment to the appealed claim.

First of all, there is no mention in any of the three secondary references of utilizing hyperspectral imaging for a missile firing system. Cuts teaches utilizing hyperspectral imaging from a vehicle in space to scan the earth for the purpose of identifying mineral or vegetative types. While the appellants have acknowledged that the system disclosed in Davies would be "suitable for use" in the claimed missile system, the reference does not mention such use, suggesting only that the system be used in "earth monitoring satellites" such as oceanography, mapping and mineral exportation, for example. The only uses suggested in the Lurie reference are in space borne cameras that monitor environmental and agricultural situations. Second, the claims before us on appeal all require that the system detect, track and guide a missile based upon the "predetermined hyperspectral signature of a target of interest" which, as we understand the teachings of the applied references, is not the manner in which these systems operate. Third, none of the applied references recognize the problems to which the appellants' invention are directed, namely, providing a target tracking system for missiles that provides a high degree of recognition and is immune to countermeasures. (Emphasis added.)

The decision in the *Nella*<sup>20</sup> case has obvious benefits to the Applicant since it does not resort to any definition of what comprises a "target." Cf. *Rahman*, construing claim term "traffic control devices" to have particular meaning in comparison to devices taught in prior art.

As a second example, in *Ex parte Abbott*, 1997-2834, the claim recited a structure for a corrosion resistant lead frame for an integrated circuit which included, *inter alia*:

an isolation layer disposed upon said base metal layer and having a second standard reduction potential, said second standard reduction potential being greater than said first standard reduction potential....

In the decision, the Board noted that Applicant's specification provided an example of the isolation layer as comprising a palladium/nickel alloy layer. However, in reversing the rejection, the isolation layer was not specifically defined by reference to such materials. Rather, the panel stated more generally "the problems to be solved and/or the solutions to the problems in the Levine patents are different from that of the present invention." In addition, in reversing the prior art rejection, the decision further explains "Since [the cited art] is

<sup>20</sup> *Nella* at pages 6-7.

concerned with a different problem relative to the claimed invention and thus a different solution, we agree with the appellant that the combined teachings of the admitted prior art and Levine '067 cannot render the subject matter of the appealed claims to be unpatentable within the meaning of 35 U.S.C. § 103."<sup>21</sup>

The case law is replete with the general concepts that references need not be directed to the same problem as an invention in order to render a claim unpatentable<sup>22</sup>; that the references themselves need not expressly teach each and every claim feature to provide motivation for a modification<sup>23</sup>; that intended use of a particular element does not confer patentability<sup>24</sup>; and that to comprise analogous art, a reference need not be pertinent to every problem with which Applicant is involved<sup>25</sup>. This case law liberates the Examiner to apply and combine prior art that may seem unrelated to the invention at hand. The wide swath of available art and rationale for their combination limits the amount of ground that Applicant can truly proclaim as new and unobvious. Therefore, there appears to be a great legal hurdle against the likelihood that an argument that the Applicant discovered a problem and solution therefor would be successful. Nevertheless, if at all feasible, arguments on appeal should address this matter of Applicant's discovery of a solution to a new problem since the benefits are so numerous. Primarily, the claim may be passed to issuance without the Board making any pronouncements in the file history on the definition of any claim term. In addition, there will be a pronouncement in the file history that Applicant was the first to identify a problem and solution. This is a strong factual component that would favor conferring "pioneer" status on the patent and a greater scope of equivalents.<sup>26</sup>

As a corollary, while the above two examples in *Nella* and *Abbott* pertain to an effect achieved by the invention over the cited art, it is

<sup>21</sup> *Abbott* at page 7.

<sup>22</sup> *Ex parte Levengood*, 28 U.S.P.Q.2d (BNA) 1300, 1302 (BPAI 1993); *In re Kamps*, 97 F.3d 1427 1430; 40 U.S.P.Q.2d (BNA) 1309, 1311 (Fed. Cir. 1996).

<sup>23</sup> *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1936 (Fed. Cir. 1988).

<sup>24</sup> *Piney Bowes, Inc. v. Hewlett Packard Co.*, 182 F.3d 1298, 1305; 51 U.S.P.Q. (BNA) 2d 1161, 1165 (Fed. Cir. 1999).

<sup>25</sup> *Ex parte Gaechter*, 65 U.S.P.Q.2d (BNA) 1690, 1692 (BPAI 2002) (unpublished).

<sup>26</sup> *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 787; 10 U.S.P.Q.2d (BNA) 1338, 1346 (Fed. Cir. 1989) (indicating that pioneer status is a question of fact) but see *Augustine Medical, Inc. v. Gaynor Indus.*, 181 F.3d 1291, 1301, 50 U.S.P.Q.2d (BNA) 1900, 1907 (Fed. Cir. 1999) (indicating that the USPTO and the courts cannot predict the future of whether any invention will open wide vistas of innovation).

important to note that the effect is actually ~~achieved by~~ the claim language. In *Nella*, the claim actually described guiding a missile according to a "flight path" of the target. Therefore, the conceptual difference between the claimed "target" and the earthbound targets in the references was fairly recited in the claims. Similarly, in *Abbot*, the relative "standard reduction potential" of the isolation layer was also described by the claims themselves, such that conceptually the claims were distinguishable over the prior art. In contrast to the above examples, panels also consistently *affirm* rejections where the Applicant argued that the invention achieved a particular effect over the prior art. However, in those cases where the rejection was affirmed, the claims were silent as to the purported improved effect.<sup>27</sup>

### 3. Semantic Distinctions Based On Definitions

Additionally, following the widespread use of dictionaries in claim construction exercises by the Federal Circuit,<sup>28</sup> the Board of Patent Appeals also turns to dictionary definitions in determining whether rejections are sustainable. In *Ex parte Abe*, 1997-2212, the claim included a "second step for decompiling the machine program, thereby producing a second high-level language source program which does not depend on any architecture...." The panel recognized that neither the specification nor the file history defined the term "decompiling" and thus relied upon a technical dictionary to ascertain the scope of the claim. In so doing, the Board determined that the cited art did not include a step for decompiling which was independent of a particular architecture, but in fact provided an opposite step of recompiling a program into an architecture dependent form. Accordingly, the Board reversed the pending rejections.

In similar manner, in *Ex parte Goumaz*, 1997-2296, the panel referred to a technical dictionary to determine the meaning of the claim term "charge amplifier." There, the Board determined that amplification required a component to increase the strength of a signal without

<sup>27</sup> See *Ex parte Cameron*, 1996-2199 (affirming rejection when Applicant argued that claimed invention exhibited a hysteresis effect that was not claimed in the independent claims); *Ex parte Abbey*, 96-0849 (affirming rejection premised on unclaimed "Venturi" effect); *Ex parte Achter*, 96-0760 (affirming rejection when speed and continuity of operation of device was not claimed by Applicant).

<sup>28</sup> *Invenness Medical Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378; 64 U.S.P.Q.2d (BNA) 1933, 1936 (Fed. Cir. 2002) *citing* *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1582; 39 U.S.P.Q.2d (BNA) 1573, 1576 (Fed. Cir. 1996).

appreciably altering its characteristic waveform. During *ex parte* prosecution, the Examiner had continually relied upon a storage capacitor as corresponding to the claimed charge amplifier. The Board noted that the passive capacitor cited by the Examiner could not correspond to the claimed amplifier.

Of course, the Board's use of dictionaries also can have the opposite effect and lead the panel to affirm a rejection. In *Ex parte Aboaf*, 1998-0261, a claim recited a type of recording head, and the outcome of the appeal turned on the proper construction of the term "modules" appearing in the claim. The panel determined that "module" is a broad and non-specific term, generally defined with respect to electronic apparatus as a "packaged functional assembly of electronic components for use with other such assemblies." *Webster's Ninth New Collegiate Dictionary*, 1990." The panel noted that the specification referred to a particular arrangement of read and write heads to make up "modules" but that the claims were not so limited. The non-specificity of the term "module" was also used throughout the cited art to identify different groupings of elements, other than those specifically identified by the Applicant. Therefore, the rejection was affirmed in part because no distinction could be made based on the general term "module."

In the decisions discussed above, the Examiner seasonably challenged any construction being argued by Applicant during the course of prosecution. In an instance where the Examiner offers no construction that is broader than that offered by Applicant, this should be pointed out in the Appeal Brief. See *Ex parte Abdelmonem*, 95-4609. In the *Abdelmonem* appeal, the panel acknowledged that the claim recitation at issue was very broad and subject to varying interpretations. However, the Examiner had never indicated that the claim step was being interpreted in making the rejections in a way that differed than that set forth by Applicant. Therefore, the Applicant's interpretation prevailed, without the panel relying on embodiments in the specification for claim interpretation purposes.

As a final note on the use of dictionaries during appeal proceedings, the Board has been known to use a dictionary to determine the definition of a term used in a *cited reference* to determine whether an appealed claim reads on the applied art.<sup>29</sup>

<sup>29</sup> *Ex parte Baccini*, 95-5066.

In view of the foregoing, an Applicant that is relying on definitional aspects of certain claim terms as a basis for distinguishing rejected claims from cited art would be well advised to consider 1) whether the Examiner has considered a broader definition in construing a claim term that is supportable; 2) whether the context of the claim recitation supports the reading being advocated; 3) whether the plain meaning either by a common dictionary or a technical dictionary results in a broader construction that would make the rejected claim readable on the applied art; and 4) whether a term used in a cited reference, while different from Applicant's terminology, nonetheless can be construed to have the same meaning either under a common or technical dictionary definition.

#### 4. Claim Interpretation For Section 112 Rejections

In decisions relating to a rejection under 35 U.S.C. § 112, second paragraph, various panels have relied on the specification to determine whether Applicant has claimed the invention with sufficient clarity. See e.g. *Ex parte Ohira*, 1999-0608; *Ex parte Ruck*, 1998-0515; *Ex parte Babel*, 1997-2977. Federal Circuit precedent gives clear direction that construction of the claim for purposes of clarity is charged to the examination process. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous. Only in this way can uncertainties of claim scope be removed, as, much as possible, during the administrative process."<sup>30</sup> The test for indefiniteness under Section 112, second paragraph, is whether the claim language when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct.<sup>31</sup>

Despite the liberal use of the specification in determining claim precision, many rejections under 35 U.S.C. § 112, second paragraph, are affirmed. In the *Ohira* and *Babel* appeal decisions, the panel had to determine whether the modifiers "substantial" and "substantially" rendered the claims indefinite. In each instance, the panel determined that the claims were indeed indefinite for including these modifiers. The result is somewhat surprising because the MPEP expressly permits latitude in use of relative terminology in claim language, including the

<sup>30</sup> In re Zletz, 893 F.2d 319, 322; 13 U.S.P.Q.2d (BNA) 1320, 1322 (Fed. Cir. 1989).  
<sup>31</sup> In re Merat, 519 F.2d 1390, 1396; 186 U.S.P.Q. (BNA) 471, 476 (CCPA 1975).

use of the term "substantially."<sup>32</sup> It is noted that both in *Ohira* and in *Babel*, the panel found that the specifications gave no specific definition of what comprised a "substantial" amount of the characteristic in question. Therefore, unlike the cases discussed in the MPEP, the specification did little to inform one skilled in the art the precise nature of the claim scope.

As an additional claim construction exercise for purposes of Section 112, second paragraph, the Board may also consider whether the terminology in question has a particular meaning to one skilled in the art by examining prior art references. In *Ex parte Takaku*, 2000-0156, Appellant presented prior art not relied upon the Examiner to demonstrate that physical characteristics of transparency would be understood by one skilled in the chemical vapor deposition art.

#### 5. Legal Arguments

The above discussions relate primarily to technical assessments based on the teachings of the prior art in comparison with appealed claims. The second major category of argument is the legal argument. Legal arguments redirect the emphasis towards the Examiner's improper application of references as set forth in MPEP. Focusing a response and appeal on the weaknesses in Examiner's rationale rather than on the actual technical teachings forces the Examiner to reveal more of his thought processes. This will help Applicants understand the Examiner's arguments, identify weaknesses of the claims, and shore up any such weaknesses prior to appeal. Focusing on the Examiner's rationale during *ex parte* prosecution also has the benefit of avoiding the inadvertent limiting of claims based on express representation of what the claimed invention "is" and "is not" in comparison to the applied art. This reduces the impact of file history estoppel in the case.

#### A. LACK OF INHERENCY IN CITED ART

A review of sample cases suggests that contemporary panels are not inclined to rely on purported implicit teachings in a reference to affirm a rejection. The hesitancy to find inherent disclosures in prior art references applies to both 1) structural features that are claimed and 2) resultant effects that are claimed. The structural features include, for example, attributes of shape of a particular element *Ex parte Turos*,

<sup>32</sup> MPEP 2173.05(b) citing In re Nehrenberg, 280 F.2d 161; 126 U.S.P.Q. (BNA) 383 (CCPA 1960); Andrew Corp. v. Gabriel Electronics, 847 F.2d 819; 6 U.S.P.Q.2d (BNA) 2010 (Fed. Cir. 1988).

2002-0022 (applied art for a shoe cleat did not inherently teach annular ring encircling a hemispherical chamber); the ratios of dimensions for deciding placement of claim elements *Ex parte Uchida*, 1999-0555; the carbon bonding in a chemical structure *Ex parte Sampath*, 1999-2173 (compound containing percentage of carbon in bound state did not require carbon bonding with molybdenum to form molybdenum carbide precipitates); and the presence of close-boiling of non-aromatics *Ex parte Macanuli*, 1998-1067.

Claimed effects include whether a rubber material is suitable for use as an "eraser" *Ex parte Rudduck*, 1999-2186 (Appellant submitted expert declaration to support position that not all rubber substances act as an eraser); whether a component is operable in a "push on, pull off" fashion *Ex parte Qiao*, 1999-2371 (indicating that Examiner's conclusion that a fastener can be disengaged by pulling is merely speculation); and whether a hanger is rotatable about a post *Ex parte Olsen*, 1999-1044.

It is noteworthy that the cases that reverse rejections based on inherency appear generally to be of more recent vintage. The concept of the lack of inherency argument is not a new one.<sup>33</sup> However, the Federal Circuit's decision in *In re Robertson* appears to have given new strength to this legal argument.<sup>34</sup> "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"<sup>35</sup> In view of the prevalence of reversals of rejections on grounds of lack of inherency of claim elements in applied art, the record should be carefully developed with regard to any viable inherency positions.

#### B. MOTIVATION TO COMBINE

The argument for teaching away from particular combinations of references has proven to be a common basis for reversing rejections under 35 U.S.C. § 103. In *Ex parte A. Said el Shami*, 93-3369, the claim for a diagnostic device for biological samples recited, in relevant

<sup>33</sup> See *In re Oelrich*, 666 F.2d 578; 212 U.S.P.Q. (BNA) 323, 326 (CCPA 1981).  
<sup>34</sup> 169 F.3d 743; 745; 49 U.S.P.Q.2d (BNA) 1949, 1951 (Fed. Cir. 1999).  
<sup>35</sup> *Id.* (Internal citations omitted.)

part, "a specific antibody binder covalently immobilized on said first solid phase support to which an analyte label is pre-reacted to saturate substantially all binding sites on said binder to form a first solid phase specific antibody binder-analyte label complex...." The Board noted that the cited art was not drawn to antibody-analyte complexes and to the extent that any analogies could be drawn, it was clear that the target DNA in the reference did not become saturated as claimed. The saturation of all the binding states in the disclosed probe would disable the DNA hybridization, which was the desired result in the reference. An additional secondary reference also included a similar deficiency since saturation of the binding sites would cause the binding sites to become occupied when the reference relied on site availability for the disclosed device to operate. It is not obvious to modify a prior art device which would lead to an inoperative construction.<sup>36</sup>

The Examiner's motivation for combining references can also be undermined by focusing on the effects of the cited art. In *Ex parte Palulu*, 1999-2068, the Examiner contended that positioning of certain operating switches onto the steering wheel of the vehicle would be obvious to minimize driver distraction from the road. However, the cited reference was operable only when the vehicle is at a stop, in an idling state or in a park position. Accordingly, there is no concern for the driver's distraction as the Examiner had postulated. The panel subsequently reversed the rejection.

Strongly contesting the propriety of combining references either under the principle that the references teach away from their combination, or that the modification or combination would render one reference inoperable for its intended purpose is valuable since as discussed above, it focuses the analysis away from particular definitions in the claim language. Moreover, in the event that it appears that the combination of art does conceptually teach each feature of the claim, then lack of motivation remains an option to traverse the rejection.

#### IV. OPTIONS TO PURSUE IF APPEAL IS NOT PURSUED

As a general rule, *ex parte* prosecution should be exhausted up through receipt of the Advisory Action after Applicant responds to a final rejection. A constructive dialog between Applicant and the Examiner

<sup>36</sup> *In re Gordon*, 733 F.2d 900, 902; 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).



may lead to an earlier issuance of the patent, while providing rigorous examination of the application. The latter has the benefit of bolstering the strength of the patent upon issuance.

If after a final rejection, Applicant receives an Advisory Action indicating that the arguments of record have not been deemed persuasive for all of the claims, Applicant still has several non-appeal options. A notice of appeal may be filed for reasons other than seeking review of a rejection by the Board. For example, because filing a Notice of Appeal automatically provides a two-month period for filing the brief,<sup>37</sup> many applicants routinely file a notice of appeal as a cheaper alternative to seeking a third month extension of time to respond to a final under § 1.136(a). Under these circumstances, and with the consent of the examiner, prosecution may proceed after filing a notice of appeal.

#### A. AMENDMENT OF CLAIMS

Under 37 C.F.R. § 1.116, after final rejection amendments which cancel claims complying with any requirement of form may be made of right, and amendments for rejected claims to place claims in better form for consideration on appeal may be admitted at the discretion of the examiner.

#### B. AMENDMENT TO OBTAIN ALLOWANCE OF CLAIMS COUPLED WITH CONTINUATION FOR REJECTED CLAIMS

In the case where some claims stand rejected and some claims are allowable, a recommended course would be to amend the allowable subject matter into condition for allowance in the subject application. To avoid or mitigate the effects of estoppel, the Applicant may file a continuation application for the rejected subject matter. The decision in *Haynes International, Inc. v. Jessop Steel Co.*,<sup>38</sup> demonstrates the benefits of pursuing cancelled subject matter in a continuation case. In *Haynes*, the Applicant was successful in obtaining reversal of rejections of certain claims in a parent application during appeal, but unsuccessful in reversing the rejection of another claim, and therefore rewrote subject matter to obtain allowance of the allowed claims. The rejected claim was canceled from the parent case. The Applicant indicated that they could conceivably garner additional technical evidence in support of the patentability of the rejected claim and subsequently filed a continuation

<sup>37</sup> See 37 C.F.R. § 1.192.

<sup>38</sup> 8 F.3d 1573; 28 U.S.P.Q.2d (BNA) 1652 (Fed. Cir. 1993).

application. However, the Applicant did not refile the rejected claim that was previously before the Board and further did not submit any new evidence for patentability in the continuation.

[C]ancellation of the claims [in the parent] did not conclusively establish that Cabot wanted to relinquish coverage of the subject matter encompassed by them, and thus did not necessarily create an estoppel. It is only when the cancellation is considered with the [Applicant's] failure to refile these claims and submit additional test data to support them, it can be said that an estoppel was conclusively established.<sup>39</sup>

*Haynes* suggests that a different case would be presented had the cancellation of rejected claims occurred while prosecution was on-going. Had that been the case, Applicant's purpose in canceling the claims could be divided from that act as a relinquishment of subject matter. *Haynes* also creates a negative inference in not pursuing cancelled subject matter from a parent case in a continuation.

#### C. AMENDMENT OF NON-ALLOWED CLAIMS

The examiner has discretion to enter an amendment placing a case in condition for allowance at any time prior to forwarding the examiner's answer on appeal. However, unless the amendment requires only a cursory review by the examiner, the appellant ordinarily will be expected to comply with 37 C.F.R. § 1.116(c), by showing "good and sufficient reasons why they are necessary and were not earlier presented."

As a practical matter, the Examiner will probably refuse entry of any claim amendment that was not deemed to place the entire application in condition for allowance. However, if Applicant determines that an amendment may persuade the Examiner of patentability, then submission of the amendment would not prejudice Applicant's position during the course of appeal. Non-entered claim amendments will not be interpreted by the Board as an indication that an Applicant is acquiescing in a rejection. An applicant is not estopped from changing his strategy during the course of good faith prosecution before the examiner. A willingness to amend the claims does not prevent appellants from challenging a rejection.<sup>40</sup>

<sup>39</sup> *Haynes* at 8 F.3d at 1578; 28 U.S.P.Q.2d (BNA) 1656.  
<sup>40</sup> Ex parte Abdelmonem, 95-4609.



#### D. SUBMISSION OF ADDITIONAL EVIDENCE

The decision whether to admit additional evidence submitted after final rejection is within the discretion of the examiner, unless prosecution is continued under one of the provisions discussed in Section E, below. Unless the additional evidence is submitted in response to a suggestion from the examiner, or is submitted in conjunction with a convincing argument presented in response to the final rejection and clearly places the application in condition for allowance, the examiner is likely to conclude that the new evidence or argument for patentability introduces new issues or requires further substantive consideration, and will not enter the new evidence.

#### E. CONTINUED PROSECUTION IN LIEU OF APPEAL

##### 1. Request For Continued Examination After Final Rejection: RCE

For applications filed after June 8, 1995, the Applicant may request further prosecution on the merits and entry of any un-entered amendments filed under 37 C.F.R. § 1.116.<sup>41</sup> Such a filing withdraws the finality of the Office Action and any submissions will be considered on the merits. The prosecution with the filing of the RCE can include submission of affidavit evidence, IDS materials, in addition to modifications to the specification and claims.<sup>42</sup> The submission may be made after the appeal process commences but must be made prior to a decision on appeal. In this circumstance, the application will be treated as being withdrawn from appeal for prosecution before the Examiner.<sup>43</sup>

##### 2. Continuation Practice

For cases filed between June 8, 1995 and before May 29, 2000, Applicant may file a continued prosecution application, including claim amendments to further describe the invention in view of the applied art.<sup>44</sup> For any application, the Applicant may also file a continuation or continuation-in-part application to define the invention and claims more particularly.<sup>45</sup>

<sup>41</sup> 37 C.F.R. § 1.114

<sup>42</sup> 37 C.F.R. § 1.114(g).

<sup>43</sup> 37 C.F.R. § 1.114(d).

<sup>44</sup> 37 C.F.R. § 1.53(d). The continuation may be filed up until expiration of the time for filing court action following a Decision on Appeal. MPEP 201.1, MPEP 711.02(o); MPEP 1214.06.

<sup>45</sup> 37 C.F.R. § 1.53(b).

#### 3. Transitional Practice

For older cases that have been pending for at least two years as of June 8, 1995,<sup>46</sup> the application is subject to the transitional provisions of 37 C.F.R. § 1.129(a). The applicant or appellant is entitled to consideration of the new amendment, evidence or submission denied entry by the examiner after final rejection, upon payment of the fee under 37 C.F.R. § 1.17(f). This submission must be made prior to filing a Brief on Appeal. It is most important to appreciate that under the GATT amendments, an appellant waives the right to continued examination of claims finally rejected in the same application under 37 C.F.R. § 1.129(a), by filing an appeal brief. Filing an appeal brief therefore terminates the right to a 17-year term in an older application, if it is necessary to file a regular continuing application after the appeal. Any such application will be restricted to a term that expires 20 years from the date of filing the first national benefit application.

#### V. CONCLUSION

Even though the patent statute permits appeal prior to final rejection of the claims, an Applicant should take the opportunity to develop discourse with the Examiner to develop arguments and a more detailed understanding of the Examiner's rationale. Successful prosecution before the Examiner will likely lead to earlier issuance of the patent because the lengthy appeal process can be avoided. Throughout *ex parte* prosecution, the Applicant should continually evaluate and strengthen his position in terms of technical arguments based on both concepts and semantics in addition to legal arguments. If it is determined that the claims are not in the best possible condition for appeal, several options are available to continue prosecution before the Examiner.

<sup>46</sup> The duration of pendency takes into account an reference made in the application to any earlier filed application under 35 U.S.C. § 120, 121 or 365(c).

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